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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,322	03/16/2005	Christina Lutz	CU-4060 BWH	8831

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EXAMINER	
CHAWLA, JYOTI	
ART UNIT	PAPER NUMBER
1794	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,322	LUTZ ET AL.	
	Examiner	Art Unit	
	JYOTI CHAWLA	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *18 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-63* is/are rejected.

7)☒ Claim(s) *63* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's submission filed on 11/18/2008 has been entered as compliant. Claims 1-32 have been cancelled and claims 33-63 are added to the current application. Claims 33-63 are pending and examined in the current application.

Claim Objections

Claim 63 is objected to because of the following informalities: Spellings of "rebaudiana" in line 3 of the claim are incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 33-63 are indefinite for the recitation of "A confectionery article based on herbal mixtures comprising an extract of a mixture of herbs" or "a mixture of herb extracts" in the claims. As recited, it is unclear whether the extract of combination of herbs, differs from the "mixture of herb extracts". Applicant's disclosure does not provide a standard for ascertaining the difference of the two phrases. For the purposes of expediting the prosecution and examination, it will be assumed that the recitation "extract of combination of herbs" of claims 33 is equivalent to "combination of herb extracts" of claim 34.

Claim 45 and 46 recite that the article may be in the "form of a solid or filled hard sweet". However, claims 45 and 46 depend from claims 39 and 40, which in turn depend from claims 35 and 36, which recite that the article is in the "form of a syrup". It

is not clear how an article that is in the form of a syrup can also be in the "form of a solid or filled hard sweet".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 33-52, and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirschner et al (US 6352713 B1), hereinafter Kirschner, in view of Zhao (2002/0132037).

Regarding claims 33 and 34, Kirschner teaches a product that may be a confectionary article (Column 8, lines 59 to Column 9, line 1) in a non liquid form (Column 8, lines 59-60) based on herbal mixtures comprising an extract of a mixture of herbs, or a mixture of herb extracts (Column 13, lines 54-57) wherein the herbs are peppermint, sage, yarrow and thyme (Column 13, lines 24-54).

Kirschner discloses that the confectionery article may include sweetener (Column 13, lines 63 and Column 14, lines 14-20) but does not disclose that the article also comprises "an extract of Stevia rebaudiana". Zhao teaches the use of an extract of Stevia rebaudiana as a sweetener confectionary articles (page 1, paragraph 0014, last sentence and paragraph 0019; also page 2, paragraph 0021). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kirschner such that the confectionary article also comprises an extract of Stevia rebaudiana. One of ordinary skill would have been motivated to modify Kirschner at least for the purpose of providing a natural sweetener that has the known benefit of providing sugar sweet taste without elevating blood glucose level (page 2, paragraph 0021, last sentence).

All limitations of claim 35 and 36 are included claims 33 and 34, except that claim 34 recites that the confectionary article in claims 35 and 36 is in "the form of syrups" instead of non liquid form. Zhao teaches that the sweetener composition may also be provided in a liquid form (page 2, paragraph 0023, last sentence) and given that it is well known in the art that confections comprising sweeteners can be solids (hard and soft chew) or liquids (or syrups), it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kirschner such that the confectionary article is in the form of a syrup. One of ordinary skill would have been motivated to modify Kirschner at least for the purpose of providing the confectionary article according to consumer preference.

Regarding claims 37-40, Kirschner teaches that the confecitonary article further comprises at least horehound (Column 13, lines 35-39).

Regarding claims 41-44, Kirschner teaches that the confecitonary article may be in the form of a hard sweet (Column 8, lines 62-67).

Regarding claims 45-48, Kirschner teaches that the confecitonary article may be in the form of solid (Column 8, lines 62-67). Note that the limitations "stamped, cast, molded, or pressed" are process limitations and hence the claim is a product by process claim. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claims 49-52, Kirschner teaches that the confecitonary article may be in the form of a chewing sweet (Column 8, lines 62-67).

Regarding claims 57-60, Kirschner teaches that the confectionary article may be in the form from which instant drinks can be prepared (such as dissolvable form and quick dissolve, see Column 8, lines 62-67).

(B) Claims 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirschner in view of Zhao as applied to claims 33-34 and 37-38, further in view of Bell et al (US 5338809), hereinafter Bell.

Kirschner in view of Zhao has been relied upon to reject claims 33-34 and 37-38 as discussed above.

Regarding claims 53-56, Kirschner teaches substantially the claimed structure but does not specifically state that that the confectionary article may be in the form of "a chewing

gum". However, chewing gums with herbal extracts and stevia extracts were known at the time of the invention, as taught by Bell (column 4, lines 37-38 and 56-61). It would have been obvious for one of ordinary skill at the time of the invention to modify the teaching of Kirschner and make a gum based confection with herb extracts including the extract of stevia, as taught by Bell. One would have been motivated to do so at least for the purpose of making the chewable confection of Kirschner last longer and make it available in a form (i.e., chewing gum form) according to consumer preference.

(C) Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oppenheimer et al (US 4980169), hereinafter Oppenheimer, in view of the combination of Kirschner (US 6352713 B1) and Zhao (2002/0132037).

Regarding claim 61-63, Oppenheimer teaches a method of producing a confectionery article comprising the extract of herbs (plant extracts, Column 6, lines 10-15), with extract of Stevia rebaudiana (Column 6, line 45 as a sweetener) and processing the resultant mixture into a confectionery article of the desired form (Column 4, line 33 to Column 6, line 15).
Regarding the steps of mixing dried herbs and extracting or mixing the extracts of at least one herb as recited in claims 61-63 it is noted that extracts are conventionally known to be obtained from dried herbs as instantly claimed. Further, Kirschner in view of Zhao teaches a confectionery product that may be a confectionary article (Column 8, lines 59 to Column 9, line 1) in a non liquid form (Column 8, lines 59-60) based on herbal mixtures comprising an extract of a mixture of herbs, or a mixture of herb extracts (Column 13, lines 54-57) wherein the herbs are peppermint, sage, yarrow and thyme (Column 13, lines 24-54) with "an extract of Stevia rebaudiana (Zhao, page 1, paragraph 0014, last sentence and paragraph 0019; also page 2, paragraph 0021). Kirschner teaches herbal extracts and combinations thereof including extracts of peppermint, sage, yarrow, and thyme as taught by Kirschner (Column 13, lines 24-57) as instantly claimed. Thus, Oppenheimer teaches of the claimed step of obtaining the extract.

Regarding the thickening of the extract, as recited includes the recitation of term "if appropriate" which is considered to mean that the thickening step is optional and is treated as such.

Regarding the limitation of mixing herbs or the extract of at least one herb with extract of stevia or mixing the herbs and stevia to obtain an extract, Oppenheimer further teaches that making confections is a well known art and provides method steps for making hard, soft, chewable type confections comprising extracts from plants (herb extracts) where the sweeteners and additives are heated to reach desired consistency (thickening) before addition of additives, such as, flavoring including herbal extracts (Column 4, line 33 to Column 6, line 15). Oppenheimer also teaches of processing the resultant mixture of sweetener and flavor extracts into confectionery article of dersired form (Column 5, lines 18-23).

Thus, methods of making confections comprising herbal extracts were known in the art at the time of invention (Oppenheimer). Herbs such as, peppermint, sage, thyme and yarrow were also known to be used together (Kirschner). Sweetener or extract derived from stevia was also well known as a sweetener for confections at the time of the invention (Zhao and Oppenheimer). Therefore, it would have been a matter of routine determination for one of ordinary skill in the art at the time of the invention to modify Oppenheimer in view of the combination of Kirschner and Zhao at least for the purpose of providing a herbal confection that also contains a natural sweetener that has the known benefit of providing sugar sweet taste without elevating blood glucose level (page 2, paragraph 0021, last sentence). One would have been further motivated to use either herbs or their extracts based on the availability of time, e.g., addition of prepared extracts will shorten the production time.

Response to Arguments

Applicant's arguments with respect to claims 33-63 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/
Examiner
Art Unit 1794

/JENNIFER MCNEIL/
Supervisory Patent Examiner, Art Unit 1794